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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,999	10/22/1999	HIROAKI KAWASAKI	MIT-103	6219

21323 7590 06/19/2003

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EXAMINER

MURPHY, JOSEPH F

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/422,999

Applicant(s)

KAWASAKI ET AL.

Examiner

Joseph F Murphy

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-37,40-47,50-117 and 121-130 is/are pending in the application.
- 4a) Of the above claim(s) 12-37,55-61,63-117 and 121-130 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40-41, 43-47, 50, 52-53 is/are allowed.
- 6) ☒ Claim(s) 42,51 and 54 is/are rejected.
- 7) ☒ Claim(s) 62 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Formal Matters

Claim 45 was amended in Paper No. 22, 4/7/2003. Claims 12-37, 40-47, 50-117, 121-130 are pending. Claims 12-37, 55-61, 63-117, 121-130 are withdrawn from consideration pursuant to 37 CFR 1.142(b). Claims 40-47, 50-54, 62 are under consideration.

Response to Amendment

The objection to claim 45 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been obviated by Applicant's amendment and is thus withdrawn.

Claim Objections

Claim 62 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim and should refer to other claims in the alternative only. See MPEP § 608.01(n). Even though this claim is in improper form, the examiner has chosen to examine claim 62.

Claim Rejections - 35 USC § 112 second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42, 51, 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 42 is vague and indefinite in the recitation of the term “may”. In the claim it is not clear whether the vector must express the protein or not, because of the inclusion of the conditional term “may” in the claim, thus the metes and bounds of the claim cannot be determined. In order to obviate this rejection, it is suggested that applicant rewrite claim 42 to read:

“Claim 42. The expression vector of claim 40 wherein said expression vector is a mammalian expression vector.”

Claims 51, 54 are vague and indefinite because they depend from claim 50, which depends on claims 41-47, wherein claim 42 is drawn to a mammalian expression vector, while claim 51 recites that the host cell is a bacterial cell or a yeast cell, and claim 54 is an invertebrate cell. It is not clear how the mammalian expression vector of claim 42 would function in the bacterial or yeast cell of claim 51 or the invertebrate cell of claim 54, thus the claims are indefinite, contradictory and confusing.

Conclusion

Claims 42, 51, and 54 are rejected.

Claim 62 is objected to.

Claims 40-41, 43-47, 50, and 52-53 are allowable.

Art Unit: 1646

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
June 18, 2003

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